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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,854	07/27/2001	Norbert A. Feliss	SJ0920000014US1	9283

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EXAMINER

SNIEZEK, ANDREW L

ART UNIT	PAPER NUMBER
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2651

DATE MAILED: 03/02/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,854

Applicant(s)

FELISS ET AL.

Examiner

Andrew L. Sniezek

Art Unit

2651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 and 31-38 is/are allowed.
- 6) ☒ Claim(s) 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because figures 1 and 2A should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Note Patent 5,229,899, which contains these figures. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 25 sets forth that the tag material "can be" detected in a vapor phase. This language does not distinctly set forth the invention. Examiner suggests replacing the phrase "can be detected" with - - is detected - -. Appropriate correction is required. Claims 26-30 inherit the language of claim 25.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

Art Unit: 2651

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flynn et al. in view of Feliss et al.

Flynn et al. teaches a lubricant that comprises a perfluoropolyether material and a halogenated sulfur material, in column 3, lines 32-56. Specifically the end groups of the lubricant as claimed can contain sulfur along with fluorine (a halogen material). Flynn et al. does not specifically state to use this material for a disk drive, however does teach (column 1, lines 5-10) to use this material in the lubrication of magnetic media. Magnetic media covers such media such as magnetic disks and magnetic tapes. Magnetic disks are well known to be used in magnetic disk drive arrangements as taught by Feliss et al. for recording information. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the lubricant for a variety of magnetic media as taught by Flynn et al. and to use such a magnetic medium in a disk drive arrangement as taught by Feliss et al. in order to provide an information storage capability.

Allowable Subject Matter

6. Claims 1-23 and 31-38 are allowed.

Art Unit: 2651

7. The following is a statement of reasons for the indication of allowable subject matter: The claimed method for detecting leakage from a disk drive enclosure with a lubricating material as set forth in claim 1 that measures a concentration of the tag material in the vapor phase is neither taught by nor an obvious variation of the art of record. Claims 2-12 depend on claim 1. The claimed disk drive as set forth in claim 16 that includes a lubricant composition comprised of a lubricant component and a tag component with the tag component having a volatility that enables it to be detected in a vapor phase is neither taught by nor an obvious variation of the art of record. Claims 17-21 depend on claim 16. The claimed disk drive as set forth in claim 22 that includes a first source of a volatile lubricant and a second source of a tag component incorporated in a non-volatile material where the tag component has a volatility that enable it to be detected in a vapor phase is neither taught by nor an obvious variation of the art of record. Claim 23 depends on claim 22. The computer system as set forth in claim 31 that includes a lubricant composition that includes a lubricant component and a tag component such that the quantity of the tag component is detected by a sensor while in its vapor phase is neither taught by nor an obvious variation of the art of record. Claims 32-38 depend on claim 31.

8. Claims 25 along with dependent claims 26-30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claim 25 along with dependent claims 26-30 would be allowed if amended along the lines as suggested by the examiner.

Art Unit: 2651

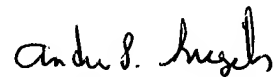
Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kuwabara et al. teaches a lubricant similar to the claimed lubricant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Snizek whose telephone number is 703-308-1602. The examiner can normally be reached on Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 703-305-4700. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Andrew L. Snizek
Primary Examiner
Art Unit 2651

A.L.S.
2/26/04